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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,425	07/30/2003	Hubert Carl Burton JR.	21861/09003	7834
27530	7590	11/29/2006		
NELSON MULLINS RILEY & SCARBOROUGH, LLP 1320 MAIN STREET, 17TH FLOOR COLUMBIA, SC 29201			EXAMINER SEMBER, THOMAS M	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,425

Applicant(s)

HERBERT CARL BURTON, JR.

Examiner

Thomas M. Sember

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 18 and 19 is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-17, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-9, 11-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoover et al '72 in view of Ludwig (D463061). Hoover et al '72 discloses the claimed invention except for the teaching of the lamp shield having two arms rather than one. Ludwig (D463061) teaches a lamp shield having two arms for attaching the shield to the ground. It would have been obvious to one skilled in the art at the time the invention was made to modify the light shield of Hoover et al '72 to include the two arm arrangement as taught Ludwig '061 rather than the one arm design of Hoover et al '72 in order to provide an alternatively effective means of securing the shield of Hoover et al '72 to the ground. Furthermore, merely changing the lamp device of Hoover et al' to include two arms rather than just one arm for holding the lamp device in the ground would have been an obvious engineering design choice since such a modification would not have any patentable significance or any unexpected results obtained by merely changing the light shield Hoover et al' 72 so as to have two arms rather than one. Please see *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)

The following elements are taught by Hoover et al '72

Regarding claim 3, the rear wall has a semi-circular shape.

Regarding claim 4, the shield further comprises at least one sidewall.

Regarding claim 5, the shield comprising two sidewalls, wherein the two sidewalls are curved and the rear wall has a semi-circular shape.

Regarding claim 6, the curved sidewalls extend from the semi-circular rear wall at substantially the same radius as the semi-circular rear wall so that the two curved sidewalls are contiguous with the semi-circular rear wall and together form a uniform semi-circular shape.

Regarding claims 7-8, an aperture 55 in the rear wall of the shield 10, wherein the aperture 55 is contiguous with the bottom edge of the rear wall.

Regarding claim 9, the shield further comprises a top that is attached to the top edge and at least partially covers that portion of the shield, which encloses the light source.

Regarding claim 11, the attachment arm is attached to the shield at the bottom edge of the rear wall.

Regarding claim 12 the attachment arm is a unitary construction contiguous with the shield (regarding the limitation of "injection molding", applicant is reminded that disclosure of only a method of making the invention and the function may not be sufficient to support a product claim other than a product-by-process claim). Thus, since Panagiotou shows an attachment arm unitary with shield, the prior art reference of Panagiotou meets this claim.

Regarding claim 13, the attachment arm comprises one or more devices selected from the group consisting of glue, screws, clamps, staples, nails, stakes,

screws, clamps, tie downs, Velcro®, tape, wire ties, buttons, snaps, weights, hooks, metal rods, or magnetic attachments.

Regarding claim 14, the attachment arm includes a stake 62.

Regarding claim 15, the attachment arm is made from a material selected from the group consisting of steel, stainless steel, aluminum alloys, iron alloys, thermoplastic polymers, thermoset polymers, and cellulosic materials.

Regarding claim 16, the rear wall is constructed from a material selected from the group consisting of metal, plastic, composite material, and cellulosic material.

Regarding claim 17, the rear wall comprises a reflective material.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Hoover et al '72. Hoover et al '72 discloses a light housing **for at least partially shielding an in-ground floodlight** comprising a shield having a rear wall 18 **located posterior to a rear portion of the in-ground floodlight, wherein the in-ground floodlight has an emitting portion located opposite the rear portion**, and wherein the rear wall has a top edge 14 and a bottom edge 20, and the **shield is separate from the in-ground**

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floodlight and is adapted to partially enclose the in-ground floodlight; and at least one attachment arm for attaching the shield to a fixed object.

NOTE * text in bold is intended use language and given little patentable weight.

Allowable Subject Matter

1. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. Claim 19 is allowed.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 3-9, 11-17 and 20 have been considered but are moot in view of the new ground(s) of rejection.
4. Applicant's arguments with respect to claim 21 are not found persuasive. In response to applicant's argument that Hoover doesn't disclose an in-ground flood light, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Furthermore, the light of Hoover et al can be broadly interpreted as an "in-ground floodlight" because applicant has not given the term a special meaning in applicant's specification. And even applicant did, an "in-ground floodlight" is never positively claimed since applicant clearly claims "**for at least partially shielding an in-ground floodlight**" which is intended use language.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lee discloses a two stake lighting apparatus similar to applicant's invention:

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is 571-272-2381. The examiner can normally be reached on M-F 8 A.M- 5.30 p.m. first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas M Sember
Primary Examiner
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